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IN THE

SUPREME COURT OF THE UNITED STATES

OCTOBER TERM, 1958

NO. 554

PREFORMED LINE PRODUCTS COMPANY
Petitioner

v.

ROBERT C. WATSON, COMMISSIONER OF PATENTS,
Respondent

PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE DISTRICT OF COLUMBIA CIRCUIT

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ROBERT C. WATSON, COMMISSIONER OF PATENTS,

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PETITION FOR CERTIORARI

To The Honorable the Chief Justice and Associate Justices of the Supreme Court of the United States:

Petitioner, Preformed Line Products Company, respectfully prays that a writ of certiorari issue to the United States Court of Appeals for the District of Columbia Circuit to review the judgment of said court entered in the above-entitled cause on September 4, 1958, and docketed in that court as Appeal No. 13,938.

Opinion Below

The opinion of the United States Circuit Court of Appeals for the District of Columbia Circuit is reported at 257 F.(2d) 664, and is reproduced as an appendix to this petition. (pp. A-1 to A-3).

Jurisdiction

The decision of the United States Circuit Court of Appeals for the District of Columbia was entered June 26, 1958, and petition for rehearing was denied without opinion on September 4, 1958.

Jurisdiction to review this case is based upon Section 1254(1) of the Judicial Code, as revised by the Act of June 25, 1948 [28 USC §1254(1)].

Questions Presented

1. In *ex parte* actions under the Statute, 35 USC §145, against the Commissioner of Patents to authorize the issuance of a patent, does the District Court have jurisdiction voluntarily to entertain the question of patentability *vel non* of claims adjudged patentable in the Patent Office record, where the patentability of such claims was conceded by both parties, and was not an issue in the case?

2. Does the language of the Statute, Title 35 USC §145, intend that the jurisdiction of the Court shall attach only as to the issues before the Board of Appeals of the Patent Office in *ex parte* cases?

3. May the Circuit Court of Appeals sanction the action of the District Court in ruling, *sua sponte*, that claims actually patented by the Commissioner of Patents, the patentability of which was not in issue, are in fact not patentable on their merits?

4. May the Circuit Court of Appeals volunteer leave for petitioner to make application for a new trial to test the patentability *vel non* of claims that were conceded to be patentable by the parties, the patentability of which was not an issue in the case; and does the trial court have jurisdic-

tion over such subject matter to grant a motion for new trial brought for this purpose?

5. Where claims have been adjudged patentable by the Patent Office, and the question of petitioner's right thereto turns upon other well defined issues, the ultimate decision on which would determine its right to a patent thereon, may the Circuit Court of Appeals properly withhold its decision as to those determinative issues, and any other issues that are ready to be decided, and, instead, voluntarily allow petitioner to make application for a new trial to test the patentability *vel non* of such claims?

6. In *ex parte* suits brought under 35 USC §145, in which the Commissioner of Patents is the party defendant before the court, as distinguished from *inter partes* actions brought under 35 USC §146 between private adverse parties, in which the Commissioner is not before the court, there is the question as to whether the pronouncements of this Court in its opinions in *Hoover* v. *Coe*, 325 U. S. 79 (an *ex parte* action) and *Hill* v. *Wooster*, 132 U. S. 693 (an *inter partes* action), are to be distinguished.

7. Refusal by this Court to issue the Writ, and in default of a new trial, the District Court's judgment dismissing the complaint will be reinstated. This would effect affirmance of the *res judicata* rulings by the District Court and the Patent Office by the Court of Appeals without opinion. Only indirectly involved here, some of the important questions that are embraced by the *res judicata* question which remain undecided are set forth in the Appendix in this petition, pp. A-20, 21.

Statute Involved

Title 35 United States Code §145 (1952):

An applicant dissatisfied with the decision of the Board of Appeals, may, unless appeal has been taken to the

United States Court of Customs and Patent Appeals, have remedy by civil action against the Commissioner in the United States District Court for the District of Columbia if commenced within such time after such decision, not less than sixty days, as the Commissioner appoints. The court may adjudge that such applicant is entitled to receive a patent for his invention, as specified in any of his claims involved in the decision of the Board of Appeals, as the facts in the case may appear and such adjudication shall authorize the Commissioner to issue such patent on compliance with the requirements of law. All the expenses of the proceedings shall be paid by the applicant.

Statement of the Case

The facts material to the questions presented are:

Thomas F. Peterson, assignor to petitioner, Preformed Line Products Company (hereinafter referred to as "petitioner"), is the inventor and applicant of two applications for patent pertaining to preformed helices for the reinforcement, splicing, armoring, and dead ending of electrical transmission lines and other wires and cables; the first, Serial No. 698, 312, being filed in the United States Patent Office on September 20, 1946 (Pl. Ex. 1A-1B, Joint App. 170); and the second, Serial No. 2,200, as a partial continuation of the subject matter of the first, being filed January 14, 1948 (Pl. Ex. 2A-2B, Joint App. 348).

The claims of the first application were rejected *inter alia* on a United States patent to one Bodendieck, No 2,414,136, issued January 14, 1947, on an application filed May 9, 1945 (Joint App. 508). Because of alleged identity of subject matter, certain claims appearing in the Bodendieck patent were copied into petitioner's first application for

purposes of interference.[1] Petitioner was denied the Bodendieck claims by the Primary Examiner on the grounds that the disclosure of the first application did not support them. Petitioner appealed this ruling to the Patent Office Board of Appeals.[2] Pending decision by that body, petitioner filed the second application, with modified disclosure, and incorporated the identical Bodendieck patented claims therein as a matter of original record. An interference (Pl. Ex. 3, Joint App. 432) was declared between petitioner's second application and the Bodendieck patent as to those claims.

As to the first application, the Board of Appeals decided (Joint App. 232) that its disclosure did support the patented claims, and so reversed the Primary Examiner. Thereupon, petitioner moved to add the first application to the intereference in support of its right to the issues thereof. The Primary Examiner dissolved the interference (Joint App. 445, 452) on the grounds that neither petitioner's first nor second application supported the claims at issue, but was ultimately persuaded to reinstate the interference, and to transmit it for final determination to the Board of Interference Examiners (Joint App. 457-459). Evidence was adduced by the parties to establish whether Peterson or Bodendieck was the prior inventor. But the Interference Board, while implying that Peterson was probably the first inventor,[3] turned its decision (Joint App. 467-479) on the Primary Examiner's earlier decision, holding lack of basis in both of petitioner's applications to support the contested claims, and so awarded priority to Bodendieck on this ground.[4]

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1. 35 U.S.C. § 135. Reproduced in the appendix to this petition, p. A-14.
2. 35 U.S.C. § 7 and § 134. Reproduced in the appendix hereto, p. A-14.
3. Joint App. 476, lines 16 *et seq.*; lines 15-20.
4. Patent Office Rule 258, reproduced in the adjoined appendix, p. A-15.

Petitioner appealed from this *inter partes* judgment to the United States Court of Customs and Patent Appeals,[5] during the pendency of which appeal, but before the formal petition to that Court, or the transcript of the record had been lodged therein, Bodendieck filed his statutory disclaimer[6] (Joint App. 489) of the contested claims, and also filed a concession of priority of invention (Joint App. 490) as to the subject matter of such claims in favor of Peterson. Peterson seasonably moved the Commissioner of Patents to vacate the Interference Board's judgment,[7] and to dismiss the appeal to the Court of Customs and Patent Appeals. The motion was denied (Joint App. 492) on alleged lack of jurisdiction in the Commissioner to entertain it. Upon notice by the patentee, Bodendieck, that the interference was terminated,[8] the Commissioner so ruled, and remanded the case to the Primary Examiner in the Patent Office for further action *ex parte* (Joint App. 503).

The Primary Examiner then finally rejected the patented claims derived from Bodendieck in both of petitioner's applications on the grounds that the Interference Board's judgment was in effect *res judicata* as to petitioner's right thereto.

On a second appeal *ex parte* to the Board of Appeals taken by petitioner from such final rejections, that body affirmed the Primary Examiner (Joint App.—1st appl'n

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5. 35 U.S.C. § 141 and § 142, reproduced in the adjoined appendix, pp. A-15, A-16.

6. Then Sec. 4917 R.S., 35 U.S.C. § 65; now 35 U.S.C. § 253, appendix hereto, p. A-16.

7. Patent Office Rules 262 and 263, reproduced in the appendix hereto, p. A-18, were invoked based on the original jurisdiction of the Commissioner. Note the District Court's order reproduced in the adjoined appendix, p. A-4, and Conclusion of Law 15 appearing at p. A-13.

8. Court of Customs and Patent Appeals, Rule XXV, reproduced herein, p. A-19.

298; 2nd appl'n 420), and upon petition for reconsideration, held (Ibid. 340; 4[illegible]0) that it was without authority to review a decision of the Interference Board, or a ruling by the Commissioner of Patents, even under the guise of a final rejection by the Primary Examiner. Petition to the Commissioner invoking the supervisory authority of that office to direct the Board of Appeals to review this final rejection of the Primary Examiner as required by Statute[9] was denied (Joint App. 348).

From this action petitioner proceeded by a bill in equity against the Commissioner of Patents to the United States District Court for the District of Columbia under the provisions of the Statute, 35 USC § 145. The District Court ruled that the Interference Board's judgment was a final judgment; and further held, *sua sponte*, that there was no patentable novelty in any of the claims before the Court, including the previously patented claims that constituted the issues of the *Peterson* v. *Bodendieck* Interference, and for these and other reasons dismissed the complaint.[10]

On appeal, the Circuit Court of Appeals, after briefs, oral hearing, and additional memoranda filed at the request of the Court, ruled that "We do not question the propriety of the District Court's action in raising, *sua sponte*, the issue of patentability *vel non*", inviting comparison with *Hill* v. *Wooster*, 132 U. S. 693, 698 (1890); *Knutson* v. *Gallsworthy*, 82 U. S. App. D. C. 304, 306-308; 164 F. (2d) 497, 499-501 (1947); *Radtke Patents Corp.* v. *Coe*, 74 App. D. C. 251, 122 F. (2d) 937 (1941), but deemed that fairness re-

9. 35 U.S.C. § 7; 35 U.S.C. § 134, *supra*.

10. The decision of the District Court was rendered orally from the bench at the conclusion of the trial. It is reproduced in the Joint Appendix at pages 44-53; Judgment and Order settling findings of fact and conclusions of law, 24-26; the Findings of Fact and Conclusions of Law are set forth in the Appendix to this petition, pp. A-4 to A-13.

quired a trial of that issue before rendition of judgment.[11] Accordingly, the Appellate Court conditionally vacated the District Court's order, and gave petitioner sixty (60) days in which to apply to the District Court for a new trial without prejudice to further appellate action in the case, either as to the disposition of such application, or as to the outcome of the new trial if granted and prosecuted.

Should petitioner fail to proceed with the application for new trial within the time allotted, the Appellate Court ordered that the District Court's judgment would in that event be reinstated. No disposition of the jurisdictional question or any of the other issues on appeal were made, and petition for rehearing was denied without opinion.

ARGUMENT FOR ALLOWING THE WRIT

Petitioner's Only Recourse is to this Court:

If petitioner's posture, respecting lack of jurisdiction in the District Court to pass upon the patentability *vel non* of claims that have already been adjudged patentable by the Patent Office, is correct, then petitioner is without standing to apply for a new trial in keeping with the Appellate Court's order. Notwithstanding this, and further in keeping with the decision below, petitioner's failure to apply for a new trial within the time allotted (as enlarged by order of court) would reinstate the District Court's judgment dismissing the complaint.[12] Obviously, then, petitioner's only recourse is to this Court for review and settlement of the jurisdictional question.

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11. Decision reproduced in the appendix to this petition, p. A-1. See note 2 in the margin, p. A-3.

12. Decision below, appendix hereto, p. A-3.

Denial of This Petition Would be Tantamount to Relegating the Functions of the Patent Office to the District Court:

An *ex parte* applicant under 35 USC § 145 brings his bill in the District Court, not to test the propriety of the actions taken that are favorable to him in the Patent Office, but for relief from the adverse rulings with which he is "dissatisfied" by the Board of Appeals in the Patent Office after all administrative processes have otherwise been exhausted. The language of the statute seems to leave no doubt that this was the legislative intent of the Congress:

> "An applicant *dissatisfied with the decision of the Board of Appeals* may . . . have remedy by civil action against the Commissioner in the United States District Court for the District of Columbia . . . The court may adjudge that such applicant is entitled to receive a patent for his invention, *as specified in any of his claims involved in the decision of the Board of Appeals*, as the facts in the case may appear and such adjudication shall authorize the Commissioner to issue such patent on compliance with the requirements of law." (Emphasis supplied)

It is not seen wherein a litigant under this section of the statute stands in any different capacity before the Court than do other litigants. It is trite law that the issues are framed by the pleadings upon which they become joined. There was no issue joined on the pleadings in this case respecting the patentability *vel non* of the claims that comprised the issues of the *Peterson* v. *Bodendieck* Interference. They were before the Board of Appeals and before the Court below on the grounds of whether the judgment of the Interference Board is *res judicata* with respect to petitioner's right to them after being disclaimed under the

statute[13] by the patentee Bodendieck ensuing such judgment.

The action of the trial Court in holding, *sua sponte*, that such claims were not patentable over the prior art,[14] over which they had been allowed in the Patent Office, was an action taken outside of the framework of the pleadings, and contrary to all the evidence and the posture of the parties before the Court. Therefore, a refusal by this Court to issue the writ sought by this petition would tacitly approve this extrajudicial course of action, and would be tantamount to relegating to the federal courts the administrative and quasi-judicial functions reserved by the Congress under the statutes to the Patent Office.[15]

Decision Below Not Consistent with Decisions of This Court

Butterworth v. Hoe, 112 U. S. 50 (1884):

In this case the Court analyzed the historic development of the Patent Statutes and concluded that the power of the Commissioner of Patents to issue a patent was absolute if he "shall deem it to be sufficiently useful and important" (p. 64), and that remedy by a bill in equity under §4915 (now U. S. C. §145, §146)[16] is appropriate only when the Commissioner decides to reject an application for a patent on the ground that an applicant is not, on the merits, entitled to it (p. 68).

The office of the Commissioner of Patents, being by

13. Formerly Sec. 4917 R.S., 35 U.S.C. §65; now 35 U.S.C. §253. Reproduced in the appendix to this petition, p. A-16.

14. Joint App. 52; Findings of Fact 30, 31; reproduced herein, p. A-11.

15. *Butterworth* v. *Hoe*, 112 U.S. 50, 64, 68.

16. § 145, *supra*, p. 4; § 146 is reproduced in the appendix hereto, p. A-16.

nature one which requires the discharge of a judicial function, has the first and final word in adjudging a claim patentable. If the Commissioner decides a claim is patentable on its merits, then his decision is not subject either to administrative or judicial review, the latter being invoked only in the case of *adverse* decisions on the merits by the Commissioner.

The present action by the District Court in declaring, *sua sponte*, unpatentable, claims that the Commissioner had adjudged patentable, is clearly opposed to the intentions of the statute as construed by this Court in *Butterworth* v. *Hoe*, *supra*.

Hill v. Wooster, 132 U. S. 693 (1889):

This case involved an interference contest between two parties, in which the patentability of the contested subject matter was passed upon by the appellate court for the first time. The losing party in the Patent Office brought his bill under §4915 R. S. in the Circuit Court. That court regarded only the question of priority of invention and entered its judgment accordingly.

On appeal to the Supreme Court, this body entered its opinion that nothing in the claims at issue constituted patentable invention.

By the Court (p. 698):

> "It necessarily follows that no adjudication can be made in favor of the applicant, unless the alleged invention for which a patent is sought is a patentable invention."

The court observed that the litigation between the parties could not be concluded solely on the issue of priority when a determination of that issue would authorize the Commis-

sioner to issue a patent to the prevailing party for the claims in interference, which would necessarily lend the court's sanction to the patentability of the invention involved.

> "But neither the Circuit Court nor this court can overlook the question of patentability."

It is a condition precedent to the declaration of an interference that the subject matter be adjudged patentable by the Commissioner (Patent Office Rule 201). There can be no interference unless the subject matter is patentable. Therefore, an *inter partes* contest, such as maintained in the *Hill* v. *Wooster* case, becomes a non-suit if the subject matter involved is not patentable. It is believed that this was the full of the intention of the court in its pronouncement in the *Hill* v. *Wooster* decision, and does not bear upon *ex parte* suits.

Hoover v. Coe, 325 U. S. 79 (1954):

This case was an *ex parte* action brought by an applicant for a patent under R. S. §4915 against the Commissioner of Patents. The question presented here was whether the District Court had jurisdiction under R. S §4915 to review the refusal of a claim for patent as not reading on the disclosure of claimant's application. The trial court ruled with the Patent Office that the claim was not supported. On appeal, the Circuit Court of Appeals for the District of Columbia Circuit raised the question, *sua sponte*, "whether (R. S. 4915) confers jurisdiction on the District Court to enter a decree which does not determine the right of the applicant to receive a patent, but which instead directs the Examiner to allow claims for the purpose of provoking subsequent interference proceedings." (p. 81)

The Appellate Court decided that the District Court

lacked jurisdiction of the suit and affirmed the judgment, dismissing the complaint.

This Court, in a careful review of Sections 4915 and 4911 R. S., held that the District Court had jurisdiction over a suit taken from the refusal of the Board of Appeals of the Patent Office to issue a patent—whatever be the grounds for such refusal. By the Court (p. 83):

> "It is evident that alternative rights of review are accorded an applicant,—one by appeal to the United States Court of Customs and Patent Appeals, the other by bill in equity filed in one of the federal district courts. In the first the hearing is summary and solely on the record made in the Patent Office (with footnote reference to R. S. 4914, 35 U. S. C. §62); in the other a formal trial is afforded on proof which may include evidence not presented in the Patent Office (with footnote reference to *Butterworth* v. *Hoe*, 112 U. S. 50, 61). Every party adversely affected by a ruling on the merits may, if he so elect, proceed by bill rather than by appeal. In the one case the adjudication in equity authorizes issue of a patent on the applicant's otherwise complying with the requirements of law.' In the other the decision 'shall govern the further proceedings in the case' in the Patent Office (with footnote reference to R. S. 4911, *supra*)."

On the question as to whether the differences between the statutory provisions of R. S. 4915 and 4911 required the holding that as to all decisions adverse to the applicant that are *not* final as to the issuance of a patent, his remedy had to be by review on appeal to the C. C. P. A., the Court pointed out that R. S. 4915 warranted no such construction, concluding (p. 84):

> "On the face of the statutes the applicant is given alternative remedies resulting in the same sort of relief

so far as concerns the further prosecution of the application in the Patent Office."

This Court then proceeded to distinguish the *Hill* v. *Wooster* case, and the case of *Radtke Patents Corp.* v. *Coe*, 122 F. 2d 937, on both of which the Court below relied, pointing to the *inter partes* nature of both of these proceedings and its own ruling (in the *Hill* case) to the effect that in a suit by an unsuccessful applicant against a successful one, "* * * if it appeared that neither application disclosed invention (a matter which should have moved the Commissioner not to declare an interference) the bill should be dismissed. The Court did not purport to decide what Patent Office rulings are reviewable under R. S. 4915." (p. 90) The Court thus reversed and remanded for further proceedings in conformity with its opinion.

The Court, in this same decision, as noted above, compared the procedures available to applicants from adverse decisions in the Patent Office in both *ex parte* and *inter partes* causes, including the right to summary review to the Court of Customs and Patent Appeals, or the right to proceed by a bill in equity in the Federal District Court, these being mutually exclusive courses of action. There seems to be little doubt that this Court regards these courses of action as equal alternative ways of review in *ex parte* cases as affects an applicant's rights before the Patent Office according to the decision in *Hoover* v. *Coe*, *supra*. It is also apparent that this judgment of claims as unpatentable (that had been held by the Patent Office to be patentable) could not happen in a summary review by the Court of Customs and Patent Appeals for obvious lack of jurisdiction over such claims. Therefore, according to

the rationale of *Hoover* v. *Coe*, it should not happen in a trial in equity for the same reasons.[17]

Conclusions

From the foregoing decisions, a difference appears to arise between *inter partes* actions, as in the *Hill* v. *Wooster* case, and *ex parte* actions, such as *Hoover* v. *Coe*. The Court of Appeals for the Third Circuit in *Starlock Mfg. Co.* v. *Kublanow*, 106 F. (2d) 495, 500, regarded it necessary for the court, as guardian of the public interest in *inter partes* cases, to determine the patentability (validity) of the claims involved, though not in issue in the case.

Justice Stevens in his dissent (pp. 955, 956) in *Radtke Patents Corp.* v. *Coe*, 122 F. (2d) 937, suggests that the court is guardian of the public interest only in cases where the Commissioner of Patents is not before the court as a party to act in that capacity. This view of the law seems consonant with the authority of the Commissioner under the Patent Statutes as discussed in *Butterworth* v. *Hoe*, *supra*, and is not inconsistent with the decisions of this Court in *Hill* v. *Wooster* and in *Hoover* v. *Coe*, *supra*.

Although at one time *inter partes* and *ex partes* actions were both enabled under the provisions of §4915 R. S., they are now separately provided for in §145 and §146, respectively, Title 35 U. S. C. As such, the *staré decisis* of the one need not be applicable to the other, as is indicated by the *Hoover* v. *Coe* and the *Hill* v. *Wooster* decisions by this Court, mentioned above. These decisions, coupled with that of *Butterworth* v. *Hoe*, are persuasive to the conclusion

17. For a discussion of the extent of appellate jurisdiction over claims adjudged patenable in the Patent Office, attention is invited to the decision in *Watson, Commissioner of Patents* v. *Bruns*, 99 U. S. App. D. C. 327; 239 F. (2d) 948.

that where the Commissioner of Patents is present as a party to the action, his decision as to the patentability of the claims on their merits cannot properly be raised under the statute. Petitioner is before the Court in just such an *ex parte* status under the provisions of 35 U. S. C. §145.

The Statute does not affirmatively empower the District Court to attack such claims as being unpatentable. There is nothing in the *ex parte* cases decided by this Court which would sanction the action of the Court of Appeals below in approving such *sua sponte* ruling by the District Court, nor in implying jurisdiction in the latter to try the patentability, *vel non*, of such claims by allowing petitioner to apply for a new trial to test that issue.

The judgment of the District Court affirming the *res judicata* rejection by the Patent Office, now provisionally vacated by the Court of Appeals, will be affirmed if this petition is denied and an application for new trial is not prosecuted. Therein will errors of construction and application of the Patent Laws, Patent Office rules, and rules of court set forth in the Appendix hereto, and the jurisdiction of the Commissioner of Patents and of the courts under the facts of this case, gain judicial sanction which should not be countenanced by this Court. The writ should issue, for, whereas, these matters are properly reserved for the Court's supervisory consideration of the merits ensuing the Writ, they may not be heard here in support of this

petition primarily concerned with the jurisdictional question.

The Writ should issue.

Respectfully submitted,

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December 1, 1958

United States Court of Appeals

FOR THE DISTRICT OF COLUMBIA CIRCUIT

No. 13938

PREFORMED LINE PRODUCTS COMPANY, APPELLANT

v.

ROBERT C. WATSON, Commissioner of Patents, APPELLEE

Appeal from the United States District Court for the District of Columbia

Decided June 26, 1958

Mr. Patrick H. Hume, with whom *Mr. C. Willard Hayes* was on the brief, for appellant. *Mr. George M. Sirilla* also entered an appearance for appellant.

Mr. George C. Roeming, Attorney, United States Patent Office, with whom *Mr. Clarence W. Moore*, Solicitor, United States Patent Office, was on the brief, for appellee.

Before FAHY, WASHINGTON and BASTIAN, *Circuit Judges*.

PER CURIAM: This is an appeal from a judgment of the District Court dismissing appellant's complaint in an action brought under 35 U.S.C. §145 (1952), asking the issuance of a patent.

Appellant is the assignee of one Peterson, who had applied for a patent entitled "Helically-Preformed Wire Envelope and Methods of Use." The original application was given Serial No. 698,312, and subsequently a second, or "continuation-in-part," application (Serial No. 2200) was filed. Certain claims were allowed in the Patent Office and others were denied there on Moxham patent No. 337,513 and on prior art. With reference to certain other claims

(26, 27, and 31 of application No. 698,312 and 27 and 28 of application No. 2200), interference was declared between appellant's application and that of one Bodendieck. This interference proceeding was decided in Bodendieck's favor.

Appellant then gave notice of an appeal to the Court of Customs and Patent Appeals from the decision in the interference proceeding. Prior to the time of the filing of the formal petition and the forwarding of the transcript of record to that court, Bodendieck filed a disclaimer in favor of appellant. Thereupon appellant moved the Commissioner of Patents to vacate the decision awarding priority to Bodendieck but the Commissioner denied this motion.[1]

Upon the final denial of appellant's claims (including those involved in the interference proceedings), the present proceeding was instituted in the District Court.

The District Court, after an extensive hearing, in an oral opinion found in favor of appellee, and, upon the filing of findings of fact and conclusions of law, the complaint was dismissed on its merits. This appeal followed.

The District Court held that, in the absence of a perfected appeal to the court of Customs and Patent Appeals, the nonvacated decision of the Board of Interference Examiners became a final judgment and, as to the claims involved in the interference proceedings, this was *res judicata*. In the District Court the Patent Office had relied

1. The Commissioner ruled that after a notice of appeal to the Court of Customs and Patent Appeals has been given the Patent Office is without authority to dismiss the appeal, and that it is not the practice of the Patent Office to vacate the decision of the Board of Interference Examiners upon the filing of a concession of priority by the party who has been successful before the Board. The time for the perfection of the appeal in the Court of Customs and Patent Appeals has long since expired.

solely on the doctrine of *res judicata* as to those claims. The District Court went further, however, and stating that it would not "pitch this case upon that point alone" held that as to all the claims there was no novelty shown—that they were taught by prior art, and that one skilled in the prior art "could certainly apply them."

The latter holding of the District Court was made notwithstanding the fact that counsel for the Patent Office advised the District Court at the outset that the issue of patentability *vel non* was not before the court. This may have lulled plaintiff-appellant into a sense of security on that issue. No issue of patentability *vel non* was argued to the District Court by the parties, nor was any evidence introduced on that issue. In the interest of justice, therefore, see 28 U.S.C. §2106 (1952), we shall vacate conditionally the District Court's order.[2] Within sixty days appellant may apply to the District Court for a new trial based on a proffer of evidence on the issue of patentability. Denial by the District Court of such an application, or that court's action upon the record made at a new trial, if held, may be appealed to this court by the losing party, and upon such new appeal all issues raised may be considered anew, unprejudiced by the present appeal or its disposition. Should appellant not apply for a new trial as herein authorized the judgment of the District Court for appellee shall be reinstated.

So ordered.

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2. We do not question the propriety of the District Court's action in raising, *sua sponte*, the issue of patentability *vel non*. Compare *Hill v. Wooster*, 132 U.S. 693, 698 (1890); *Knutson v. Gallsworthy*, 82 U.S. App. D.C. 304, 306-08, 164 F.2d 497, 499-501 (1947); *Radtke Patents Corp. v. Coe*, 74 App. D.C. 251, 122 F.2d 937 (1941). But we think that under all the circumstances here fairness called for a trial of the issue before the rendition of judgment.

FINDINGS OF FACT AND CONCLUSIONS OF LAW

The following are the Findings of Fact and Conclusions of Law adopted by the trial Court (Order, Joint App. 25, 26) as set forth in the Joint Appendix at pages 26 to 35, and 38 to 40, all inclusive, except that plaintiff's proposed Conclusions of Law, P-1, P-5, P-7, P-10, and P-11, allowed by the Court, have been renumbered in the Conclusions of Law set forth below as Nos. 1 to 18, inclusive, so as to follow consecutively Conclusions of Law 1 to 13, inclusive, as submitted by the defendant and adopted by the Court.

Note that in denying defendant's motion (Joint App. 41) to amend Conclusions of Law by striking plaintiff's Conclusion of Law P-5 (Conclusion of Law 15 below), the Court entered the following order (Joint App. 43):

> "ORDERED that paragraph (1) of the defendant's Motion to Amend Conclusions of Law be and the same is hereby denied, it being the ruling of the Court that the Commissioner of Patents has original jurisdiction of interference proceedings such as Interference No. 83,266; that the United States District Court for the District of Columbia and the United States Court of Customs and Patent Appeals have alternate statutory review; and that the United States Court of Appeals for the District of Columbia Circuit and the United States Supreme Court have appellate jurisdiction; • • •"

FINDINGS OF FACT

1. This is an action brought under Title 35 of the United States Code, Section 145, in which plaintiff, Preformed Line Products Company, sought to have the Court authorize the allowance of claims 3, 6, 7, 10, 11, 15 through 20, 22, 24, 26, 27, 30, and 31 of Peterson patent application Serial No. 698,312, claims 4, 5, 8, 9, 14, 21, and 25 having been

allowed by the examiner and claims 12, 13, and 23 having been held patentable by the Board of Appeals. Claims 6, 7, 10, 11, and 22 were eliminated from the case by the granting prior to trial of plaintiff's motion to dismiss as to those claims.

2. In this action plaintiff further sought to have the Court authorize the allowance of claims 1 through 11, 13 through 16, and 21 through 28 of Peterson patent application Serial No. 2,200, which claims are all the rejected or nonallowed claims remaining therein.

3. The applications in suit disclose preformed helical elements and various species of tube-like structures produced from such preformed helical elements for use as envelopes for elongated bodies, cable splices, vibration dampeners, etc. Each application discloses also at least one specific method of assembling preformed helical elements as an envelope on a core.

4. Claims 16, 17, 18, 20, and 24 of application Serial No. 698,312 and Schedule A of the complaint are not readable on the species elected for prosecution in that application in the absence of an allowable generic claim and, therefore, are not before the court for judgment on the merits. Claims 3, 15, 19, 26, 27, 30, and 31 set forth in the same application and schedule are before the Court on the merits.

5. Claims 1 through 5, 7, 9 through 11, 13, 14, 15, 21, and 22 of application Serial No. 2,200 and Schedule B of the complaint are not readable on the species elected for prosecution in that application in the absence of an allowable generic claim and, therefore, are not before the Court for judgment on the merits. Claims 6, 8, 16, and 23 through 28 set forth in the same application and schedule are before the Court on the merits.

6. Claims 26, 27, and 31 of the earlier Peterson application are identical with claims 27, 28 and 16, respectively, of the later Peterson application.

7. The following findings 9 through 21 are pertinent to the issue of *res judicata* involved in claims 26, 27, and 31 of the earlier Peterson application and claims 27 and 28 of the later Peterson application.

8. All the facts of following findings 9 through 16, 19, 20, and 21 are pleaded in plaintiff's complaint and are admitted in defendant's answer.

9. After claims of the earlier Peterson application were rejected on Bodendieck patent No. 2,414,136, issued January 14, 1947, Peterson copied claims from said patent in that application for purposes of interference with said patent. After final rejection of the copied claims on the ground that the disclosure of the earlier application does not support them, an appeal was taken to the Board of Appeals (Appeal No. 15,663).

10. During the pendency of that appeal, Peterson filed the later of the applications involved in this action and designated it a continuation-in-part of the earlier application. The later application included original claims copied from the Bodendieck patent No. 2,414,136 which claims were identical with similarly copied claims in the earlier application.

11. Interference No. 83,266, Peterson v. Bodendieck, was subsequently declared between Peterson's later application and the said Bodendieck patent on the claims copied therefrom.

12. Subsequently, the Board of Appeals in above-mentioned Appeal No. 15,663 reversed the examiner to the

extent of holding that Peterson's earlier application would support certain claims copied from the Bodendieck patent.

13. Thereafter, Peterson moved to add his earlier application to Interference No. 83,266 in support of the issues thereof.

14. The examiner then dissolved the interference on the ground that the counts were not supported by either of Peterson's applications; but he was subsequently persuaded to permit the interference to proceed to final hearing for determination of the question of support for the claims.

15. In its decision on final hearing, the Board of Interference Examiners adopted the reasoning of the examiner in his decision dissolving the interference and held that Peterson could not make the claims derived from the Bodendieck patent in either of his applications. Priority of invention was awarded to Bodendieck.

16. Timely notice of appeal to the Court of Customs and Patent Appeals, in accordance with 35 U.S.C. 59a, R.S. 4911, then in effect, was given by applicant to the Commissioner of Patents from the above-mentioned decision of the Board of Interference Examiners, and no election was made by Bodendieck to have further proceedings conducted under 35 U.S.C. 63, R.S. 4915, then in effect.

17. Thereafter, but prior to expiration of the time available for perfecting the appeal to the Court of Customs and Patent Appeals, Bodendieck filed a statutory disclaimer (under 35 U.S.C. 65, R.S. 4917, then in effect) of his patent claims at issue in the interference proceedings and also Bodendieck's concession of priority of invention in the subject matter of the interference counts to Peterson.

18. Thereafter, in the Patent Office applicant seasonably moved to vacate the judgment of the Board of Interference Examiners in above-mentioned Interference No. 83,266, and further moved to dismiss the *inter partes* appeal to the Court of Customs and Patent Appeals; but his motions were denied by the Assistant Commissioner of Patents.

19. Subsequently, after Bodendieck filed a paper noting that Peterson had not perfected his appeal to the Court of Customs and Patent Appeals within the time allowed, the Assistant Commissioner ruled that, under Rule XXV of said Court, the interference proceedings were terminated and the Peterson applications were to be remanded to the primary examiner for further prosecution.

20. The examiner thereafter finally rejected the claims derived from the Bodendieck patent, as well as other claims held not to distinguish materially therefrom, in both the earlier and later Peterson applications on the basis of the decision of the Board of Interference Examiners at final hearing in Interference No. 83,266, holding that Peterson's applications do not support those claims.

21. On appeals from the final rejections, the Board of Appeals (Appeals No. 343-33 and No. 343-34) held that the rejection of the claims mentioned in finding of fact 20 and including all the claims mentioned in finding of fact 7 was essentially on the ground of *res judicata* and affirmed the examiner.

22. On the same appeals, the Board of Appeals did *not* hold that the doctrine of *res judicata* was applicable to the same claims on the basis of the decision of the Board of Appeals in Appeal No. 15,663, mentioned above in findings of fact 9 and 12.

23. The Moxham patent No. 337,513 of March 9, 1886, discloses a wire cable formed of a plurality of preformed helical wires which are identical in shape with Peterson's preformed wires but of no definite length. The cable may be made with or without an internal core. If a core is used, the internal diameter of the preformed helical wire may be equal to or slightly less than that of the core. The resulting structure is elastic and compact. When the core is omitted, there is produced a tube of indefinite length composed of helices which are mutually coherent.

24. Claims 3, 15, 19, and 30 of the earlier application include neither an express nor implied limitation as to length. These claims distinguish from Moxham only in matters of degree expressed in terms of intended purpose, function, desired characteristic, or capability. These claims fail to distinguish structurally in matters of kind from Moxham. These claims do not define invention over Moxham.

25. Claims 6 and 8 of application Serial No. 2,200 which recite "a vibration dampener for suspended lines" distinguish from a length of the Moxham cable only in terms of intended use. The substance of the clause "adapted for connection with the line" is inherent in almost any free body and particularly in that of Moxham. The core of Moxham is a "filler substance" and occupies the central portion as well as other portions of the envelope tube. These claims define no invention over Moxham.

26. The publication entitled "P.F.T. Preformed Armor Rods and Multiple Wire Ties" bears a copyright date of 1946 and discloses a pair of wrenches and their use in applying preformed helical armor wires to energized power lines without interrupting service. Half of the rods are placed in the upper oblong slot and the other half into the lower slot of each tool. In position with respect to the

line, the jaws are closed and while one wrench is held stationary the other wrench is rotated and moved outwardly to effect the wrapping for one-half the longitudinal extent of the armor. This latter wrench is then clenched over the armor and held stationary while the formerly stationary wrench is rotated around the line and moved outwardly toward the other end to complete the wrapping.

27. Claim 16 of application Serial No. 2,200 was held by the Board of Appeals to be adequately supported by the disclosure of that application. This claim is identical with claim 31 of application Serial No. 698,312; but since the decision of the Board of Interference Examiners, holding said claim 31 not supported by the disclosure of application Serial No. 698,312, is in this action found to establish *res judicata* as to that issue, claim 16 is supported only by the disclosure of application Serial No. 2,200, filed January 14, 1948, and is fully anticipated by the disclosure of the 1946 "P.F.T." publication which constitutes a statutory bar.

28. Claims 27 and 28 of application Serial No. 2,200 are identical with claims 26 and 27 of application Serial No. 698,312. Since the decision of the Board of Interference Examiners holding said claims 27 and 28 not supported by the earlier application is in this action found to establish *res judicata* on that issue, those claims have no effective filing date prior to January 14, 1948. Claim 27 is fully anticipated by the disclosure of the "P.F.T." publication of date 1946 which constitutes a statutory bar. Claim 28 differs from the "P.F.T." publication disclosure only in the limitation "outwardly toward both ends . . . simultaneously." The substance of that limitation is such that the subject matter of this claim would have been obvious at the time the alleged invention was made to a person hav-

ing ordinary skill in the art. Claim 28 sets forth no invention over the "P.F.T." publication.

29. Claims 23 through 26 of application Serial No. 2,200, drawn to method, are inadequately supported by the application disclosure. Claims 23 and 24 are not supported by disclosure of either "simultaneously twisting the groups" or "mutually twisting said helical units." Claims 23 through 26 are not supported by disclosure of how the groups of elements are to be maintained in the relationship recited in these claims.

30. None of claims 3, 15, 19, 26, 27, 30, and 31 of amended Schedule A and claims 6, 8, 16, and 23 through 28 of Schedule B of the complaint distinguishes patentably over the Moxham patent.

31. None of claims 3, 15, 19, 26, 27, 30, and 31 of amended Schedule A and claims 6, 8, 16, and 23 through 28 of Schedule B of the complaint distinguishes patentably over the cited prior art.

32. Plaintiff has failed to prove clear error or lack of rational basis in the findings of fact in the decisions of the Board of Appeals in Appeals No. 343-33 and No. 343-34.

CONCLUSIONS OF LAW

1. The doctrine of *res judicata* is applicable to final decisions of Patent Office tribunals including the Board of Interference Examiners.

2. The decision of the Board of Appeals in Appeal No. 15,663 is not a final decision and, therefore, a holding of *res judicata* could not properly be based thereon.

3. In the absence of a perfected appeal after Peterson's notice of appeal to the Court of Customs and Patent Ap-

peals from the judgment of the Board of Interference Examiners awarding priority to Bodendieck in Interference No. 83,266, the unvacated judgment of that Board became a final judgment.

4. The Board of Appeals correctly held in Appeals No. 343-33 and 343-34 that the question of Peterson's right to make in his applications the respective claims listed in finding of fact No. 5 was *res judicata* on the basis of the decision of the Board of Interference Examiners at final hearing in Interference No. 83,266.

5. No patentable distinction is involved in mere matters of degree.

6. A claim is functional and unpatentable if it seeks to define the essential substance of an alleged invention in structure or apparatus merely by statements of intended purpose, result, desired characteristic or capability, or a mode of operation instead of by structure or by means for achieving the desired end.

7. Limitations not within the specific provisions of 35 U.S.C. 112 and involving merely introductory matter, statements of intended use, or "adapted" clauses, are patentably ineffective.

8. A patent may not be obtained if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.

9. Plaintiff is not entitled to prevail in the absence of demonstration of clear error or lack of rational basis in the decisions of the Board of Appeals in Appeals No. 343-33 and No. 343-34.

10. Plaintiff is not entitled to a patent containing any of claims 3, 15, 19, 26, 27, 30, and 31 set forth in amended Schedule A of the complaint.

11. Plaintiff is not entitled to a patent on application Serial No. 698,312, containing any of claims 6, 7, 10, 11, and 22 of original Schedule A of the complaint, which claims were eliminated by granting of plaintiff's motion to dismiss and amend.

12. Plaintiff is not entitled to a patent containing any of claims 6, 8, 16, and 23 through 28 set forth in Schedule B of the complaint.

13. The complaint should be dismissed as to all the claims.

14. The Court has jurisdiction over the parties and over the subject matter in suit.

15. The Commissioner of Patents had original jurisdiction over the parties and over the applications and patent involved in Interference No. 83,266 at the time the party Bodendieck filed his disclaimer and concession of priority therein.

16. The authority of the Board of Appeals to review adverse decisions of Examiners upon applications for patents is contained in Title 35 U. S. Code, §7, and an applicant's right to a review from adverse decisions of Examiners is contained in Title 35 U. S. Code, §134.

17. An interference is a proceeding between two or more applications, or between one or more applications and a patent of different parties, all of which contain claims directed to the same invention.

18. The statutory disclaimer speaks from the date of the patent.

STATUTES AND RULES CITED

STATUTES

35 USC § 7:

The examiners-in-chief shall be persons of competent legal knowledge and scientific ability. The Commissioner, the assistant commissioners, and the examiners-in-chief shall constitute a Board of Appeals, which, on written appeal of the applicant, shall review adverse decisions of examiners upon applications for patents. Each appeal shall be heard by at least three members of the Board of Appeals, the members hearing such appeal to be designated by the Commissioner. The Board of Appeals has sole power to grant rehearings.

35 USC § 134:

An applicant for a patent, any of whose claims has been twice rejected, may appeal from the decision of the primary examiner to the Board of Appeals, having once paid the fee for such appeal. (R. S. 4909; 35 U. S. C., 1946 ed., 57.)

35 USC § 112 (Last paragraph):

An element in a claim for a combination may be expressed as a means or step for performing a specified function without the recital of structure, material, or acts in support thereof, and such claim shall be construed to cover the corresponding structure, material, or acts described in the specification and equivalents thereof. (R. S. 4888; 35 U. S. C., 1946 ed., 33.)

35 USC § 135:

Whenever an application is made for a patent which, in the opinion of the Commissioner, would interfere with any

pending application, or with any unexpired patent, he shall give notice thereof to the applicants, or applicant and patentee, as the case may be. The question of priority of invention shall be determined by a board of patent interferences (consisting of three examiners of interferences) whose decision, if adverse to the claim of an applicant, shall constitute the final refusal by the Patent Office of the claims involved, and the Commissioner may issue a patent to the applicant who is adjudged the prior inventor. A final judgment adverse to a patentee from which no appeal or other review has been or can be taken or had shall constitute cancellation of the claims involved from the patent, and notice thereof shall be endorsed on copies of the patent thereafter distributed by the Patent Office.

A claim which is the same as, or for the same or substantially the same subject matter as, a claim of an issued patent may not be made in any application unless such a claim is made prior to one year from the date on which the patent was granted.

35 USC § 141:

Appeal to Court of Customs and Patent Appeals

An applicant dissatisfied with the decision of the Board of Appeals may appeal to the United States Court of Customs and Patent Appeals, thereby waiving his right to proceed under section 145 of this title. A party to an interference dissatisfied with the decision of the board of patent interferences on the question of priority may appeal to the United States Court of Customs and Patent Appeals, but such appeal shall be dismissed if any adverse party to such interference, within twenty days after the appellant has field notice of appeal according to section 142 of this title, files notice with the Commissioner that he elects

to have all further proceedings conducted as provided in section 146 of this title. Thereupon the appellant shall have thirty days thereafter within which to file a civil action under section 146, in default of which the decision appealed from shall govern the further proceedings in the case. (R. S. 4911; 35 U. S. C., 1946 ed., 59a.)

35 USC § 142:

When an appeal is taken to the United States Court of Customs and Patent Appeals, the appellant shall give notice thereof to the Commissioner, and shall file in the Patent Office his reasons of appeal, specifically set forth in writing, within such time after the date of the decision appealed from, not less than sixty days, as the Commissioner appoints. (R. S. 4912; 35 U. S. C., 1946 ed., 60.)

35 USC § 146:

Any party to an interference dissatisfied with the decision of the board of patent interferences on the question of priority, may have remedy by civil action, if commenced within such time after such decision, not less than sixty days, as the Commissioner appoints or as provided in section 141 of this title, unless he has appealed to the United States Court of Customs and Patent Appeals, and such appeal is pending or has been decided. In such suits the record in the Patent Office shall be admitted on motion of either party upon the terms and conditions as to costs, expenses, and the further cross-examination of the witnesses as the court imposes, without prejudice to the right of the parties to take further testimony. The testimony and exhibits of the record in the Patent Office when admitted shall have the same effect as if originally taken and produced in the suit.

Such suit may be instituted against the party in interest as shown by the records of the Patent Office at the time of the decision complained of, but any party in interest may become a party to the action. If there be adverse parties residing in a plurality of districts not embraced within the same state, or an adverse party residing in a foreign country, the United States District Court for the District of Columbia shall have jurisdicion and may issue summons against the adverse parties directed to the marshal of any district in which any adverse party resides. Summons against adverse parties residing in foreign countries may be served by publication or otherwise as the court directs. The Commissioner shall not be a necessary party but he shall be notified of the filing of the suit by the clerk of the court in which it is filed and shall have the right to intervene. Judgment of the court in favor of the right of an applicant to a patent shall authorize the Commissioner to issue such patent on the filing in the Patent Office of a certified copy of the judgment and on compliance with the requirements of law. (R. S. 4915; 35 U. S. C., 1946 ed., 63. Act Mar. 3, 1927, ch. 364, 44 Stat. 1394 and Oct. 31, 1951, ch. 655, sec. 53a, 65 Stat. 728; 35 U. S. C., 1946 ed. 72a.)

Sec. 4917 R. S. (Then 35 USC § 65; now 35 USC § 253):

Whenever, through inadvertence, accident, or mistake, and without any fraudulent or deceptive intention, a patentee has claimed more than that of which he was the original or first inventor or discoverer, his patent shall be valid for all that part which is truly and justly his own, provided the same is a material or substantial part of the thing patented; and any such patentee, his heirs or assigns, whether of the whole or any sectional interest therein, may, on payment of the fee required by law, make disclaimer of such parts of the thing patented as he shall not choose to claim or to hold by virtue of the patent or assignment,

stating therein the extent of his interest in such patent. Such disclaimer shall be in writing, attested by one or more witnesses, and recorded in the Patent Office; and it shall thereafter be considered as part of the original specification to the extent of the interest possessed by the claimant and by those claiming under him after the record thereof. But no such disclaimer shall affect any action pending at the time of its being filed, except so far as may relate to the question of unreasonable neglect or delay in filing it. [See R. S. secs. 973, 4922.]

PATENT OFFICE RULES

Rule 258:

In determining priority of invention, the Board of Patent Interferences will consider only priority of invention on the evidence submitted. Questions of patentability of a claim generally will not be considered in the decision on priority; and neither will the patentability of a claim to an opponent be considered, unless the non-patentability of the claim to the opponent will necessarily result in the conclusion that the party raising the question is in fact the prior inventor on the evidence before the Office, or relates to matters which have been determined to be ancillary to priority and must be considered, but a party shall not be entitled to raise such non-patentability unless he has duly presented and prosecuted a motion under rule 232 for the dissolution upon such ground or shows good reason why such a motion was not presented and prosecuted.

Rule 262(a) and (d):

Disclaimer, concession, abandonment. (a) An applicant or a patentee involved in an interference may, at any time, file a written disclaimer or concession of priority, or abandonment of the invention, signed by the inventor in person with the written consent of the assignee when there has

been an assignment. Upon the filing of such an instrument by any party, judgment shall be rendered against him.

* * *

(d) Such disclaimer, concession of priority, abandonment of the invention, or abandonment of the contest shall operate without further action as a direction to cancel the claims involved from the application of the party making the same on termination of the interference on the basis thereof.

Rule 263:

Statutory disclaimer by patentee. The disclaimer referred to in rule 262, when made by a patentee in interference is not a disclaimer under 35 U. S. C. 253. If a disclaimer under the statute (see rule 321) cancelling claims involved in the interference from the patent, is made by the patentee, including all assignees as shown by the records of the Patent Office, the interference will be dissolved pro forma as to such claims.

COURT OF CUSTOMS & PATENT APPEALS

Rule XXV (1.):

PETITION OF APPEAL—TRANSCRIPT OF RECORD

1. In appeals from the Patent Office the appealing party shall file in the clerk's office a petition, addressed to the court, in which he shall briefly set forth and show that he has complied with the requirements of sections 4912 and 4913 of the Revised Statutes of the United States to entitle him to an appeal, and praying that his appeal may be heard upon and for the reasons assigned therefor to the Commissioner. Said reasons for appeal having been filed with the Commissioner of Patents and made a part of the record, shall not be repeated in the petition of appeal. Said petition of appeal and a certified copy of the record in the proceeding shall be filed in this court and the case duly

docketed within 40 days (exclusive of Sundays and legal holidays) from the date upon which said reasons for appeal were filed with the Commissioner of Patents: *Provided*, That the commissioner may for special and sufficient cause extend such time to some definite and fixed date: *Provided, further*, That in inter partes cases appellant shall, at the time of filing said petition of appeal in this court, or within 10 days thereafter, serve a copy thereof upon appellee or his counsel.

If said petition of appeal and copy of said record shall not be filed within said period of 40 days, unless such time be extended by the commissioner as heretofore provided, the commissioner, upon such facts being brought to his attention by motion of the appellee in inter partes cases, duly served upon the appellant or his attorney, and upon his own motion in ex parte appeals, may take such further proceedings in the case as may be necessary to dispose of the same as though no notice of appeal had ever been given. *Provided, however*, That if any adverse party in an interference case shall, within 20 days after appellant shall have filed notice of appeal to this court, file notice with the Commissioner of Patents that he elects to have all further proceedings conducted as provided in section 4915 of the Revised Statutes, certified copies of the notice of appeal and the notice of election shall be transmitted to this court by the Commissioner of Patents for appropriate action according to law.

QUESTIONS PRESENTED BY THE *res judicata* REJECTION

1. In an interference proceeding, where the prevailing party before the Patent Office Board of Interference Examiners filed a statutory disclaimer of the claims at issue during pendency of an appeal from that judgment to the

Court of Customs and Patent Appeals, what effect does such disclaimer have upon the judgment appealed from?

2. Upon motion duly brought, was it not within the original jurisdiction of the Commissioner of Patents to vacate the judgment of the Interference Board after the disclaimer and a concession of priority were filed? If so, did not the Patent Office Rules 262(a) and (d), and 263, make it mandatory upon him to do so?

3. In respect of Question 2, above, are Rules 262(a) and (d), and 263 of the Patent Office, and Rule XXV of the CCPA, in conflict as to the authority of the Commissioner of Patents to act under his original jurisdiction, or do these rules mutually reinforce one another under the facts of this case?

4. In subsequent *ex parte* proceedings, where the Examiner applies the interference judgment adversely to appellant's right to certain claims, is such action by the Examiner reviewable by the Patent Office Board of Appeals under 35 USC §7 and §134?

5. Where the adverse judgment in the interference turned upon the ground that appellant lacked disclosure to support the claims at issue in his earlier application in suit; and where, prior to said judgment, the Board of Appeals had ruled *ex parte* in favor of appellant on this same issue to the effect that his earlier application disclosure did support the claims at issue: Upon resumption of the *ex parte* prosecution of said application following the *inter partes* judgment and disclaimer referred to above, which, if either, was the law of the case—the *inter partes* judgment, or the original *ex parte* ruling of the Board of Appeals?

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In the Supreme Court of the United States

[illegible]

PEPPERING LEAD PENCIL COMPANY, PETITIONER

v.

ROBERT C. WATSON, COMMISSIONER OF PATENTS

ON PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE DISTRICT OF COLUMBIA CIRCUIT

BRIEF FOR THE RESPONDENT IN OPPOSITION

[illegible],
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[illegible],
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Attorneys,
Department of Justice, Washington 25, D. C.

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In the Supreme Court of the United States

OCTOBER TERM, 1958

No. 554

PREFORMED LINE PRODUCTS COMPANY, PETITIONER

v.

ROBERT C. WATSON, COMMISSIONER OF PATENTS

ON PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE DISTRICT OF COLUMBIA CIRCUIT

BRIEF FOR THE RESPONDENT IN OPPOSITION

OPINIONS BELOW

The findings of fact, conclusions of law, and the oral opinion of the United States District Court for the District of Columbia (R. 26–35, 44–53) are unreported. The opinion of the United States Court of Appeals for the District of Columbia Circuit (Pet. App. A1–A3) is reported at 257 F. 2d 664.

JURISDICTION

The judgment of the Court of Appeals was entered on June 26, 1958. A timely petition for rehearing was denied on September 4, 1958. The petition for a writ of certiorari was filed on December 3, 1958. The jurisdiction of this Court is invoked under 28 U. S. C. 1254 (1).

QUESTIONS PRESENTED

1. Whether this Court should exercise its extraordinary power to review a non-final decree by the Court of Appeals, which decree conditionally vacates a District Court order subject to the petitioner's applying to the District Court for a new trial.

2. Whether the District Court has jurisdiction to review *sua sponte* the patentability of claims which the Patent Office rejected for reasons other than non-patentability.

STATUTE INVOLVED

35 U. S. C. 145 provides:

> An applicant dissatisfied with the decision of the Board of Appeals may unless appeal has been taken to the United States Court of Customs and Patent Appeals, have remedy by civil action against the Commissioner in the United States District Court for the District of Columbia if commenced within such time after such decision, not less than sixty days, as the Commissioner appoints. The court may adjudge that such applicant is entitled to receive a patent for his invention, as specified in any of his claims involved in the decision of the Board of Tax Appeals, as the facts in the case may appear and such adjudication shall authorize the Commissioner to issue such patent on compliance with the requirements of law. All the expenses of the proceedings shall be paid by the applicant.

STATEMENT

On May 9, 1945, Bodendieck applied for a patent for a "method and apparatus for wrapping armor wire

on energized conductors". This patent was issued on January 14, 1947 (R. 512). On September 20, 1946, Peterson, the petitioner's assignor, filed a patent application covering "helically-preformed wire envelope and methods of use" (R. 170–188). The claims contained in this application were rejected on May 14, 1947, in part because the method claimed was "clearly disclosed" in the Bodendieck patent (R. 189–191). Peterson thereupon amended his application by adding four claims (claims 26 through 29) copied verbatim from the Bodendieck patent, in order to establish an interference (R. 191–197). The Primary Examiner, however, rejected these claims because they were not supported by Peterson's disclosure (R. 198–199), and adhered to that rejection after Peterson submitted additional argument (R. 199–202). Peterson then appealed ex parte to the Board of Appeals (R. 203–204). While this appeal was pending, Peterson filed a second application, similar to the first, but with a modified disclosure (R. 348–361c). The Primary Examiner declared an interference between the Bodendieck patent and the second Peterson application, and forwarded the case, for inter partes proceedings, to the Examiner of Interferences (R. 364–365).

On July 2, 1948, the Board of Appeals affirmed the rejection by the Primary Examiner of claims 28 and 29 of Peterson's first application, but held that claims 26 and 27 were supported by the disclosure in that application (R. 232–236). Peterson thereupon moved to add claims 26 and 27 of his first application to the interference (R. 437–439), but the Primary Examiner

denied this motion because Peterson had not shown "good cause" for adding the claims (R. 439–441). In addition, the Primary Examiner dissolved the interference on the ground that neither of the disclosures contained in Peterson's first and second applications supported the claims he copied from the Bodendieck patent[1] (R. 439–441; 445–452). Upon reconsideration, pursuant to Peterson's request, the Examiner, while adhering to his original position, decided, "in the interest of expediency to allow the interference to proceed to final hearing * * *" (R. 453–454; 457–459).

On May 23, 1950, the Board of Interference Examiners awarded priority of invention to Bodendieck. It held that (1) the claims which Peterson copied from Bodendieck were not supported by either of Peterson's applications, and (2) Peterson, as junior party, had not carried his burden to show priority of invention,[2] (3) the Board was "not convinced that Peter-

[1] The prior ruling by the Board of Appeals that claims 26 and 27 were supported by the disclosure in Peterson's first application was not binding upon the Examiner in the inter partes interference proceeding because the Board of Appeals decision was part of an ex parte proceeding.

[2] The petitioner reads the Interference Board's decision to imply "that Peterson was probably the first inventor" (Pet. 5), citing R. 476 and 478. The reference on R. 476 is a statement by the Board that, while Peterson's "oral testimony tends to prove that he reduced the method in issue to practice prior to the entry of the senior party into the field * * *", his exhibits suggested that this was untrue. And the reference on R. 478 is an observation by the Board that "[i]n performing the vast number of demonstrations which he alleges he has performed it would be very unusual indeed if he has not performed the method here in issue but if he did perform this method it was accidental and not appreciated."

son appreciated and unequivocally and consistently practiced the method defined in the counts in issue", and (4) Peterson had not proven that Bodendieck derived the invention from Peterson (R. 467–479).

On August 25, 1950, Peterson noted an appeal from the Interference Board's decision in the Court of Customs and Patent Appeals (R. 482–485). His period for filing a petition of appeal and transcript of record was twice extended, the latter extension expiring on December 22, 1950 (R. 486–489). On December 4, 1950, however, Bodendieck executed a statutory disclaimer of his patent rights, and conceded priority of invention to Peterson (R. 489–490). Peterson thereupon moved the Commissioner of Patents to (1) vacate the judgment of the Interference Board awarding priority to Bodendieck and enter judgment for Peterson, (2) remand the Peterson application to the Primary Examiner for ex parte processing for letters patent, and (3) dismiss, with prejudice to Bodendieck, the appeal pending in the Court of Customs and Patent Appeals (R. 490–491). The Assistant Commissioner, however, denied the motion on the ground that, after notice of appeal has been filed with the Court of Customs and Patent Appeals, the Commissioner lacks jurisdiction to dismiss the appeal, or to vacate the judgment of the Interference Board (R. 492). On March 21, 1951, Bodendieck notified the Commissioner that he had withdrawn from the case by disclaimer and concession. He also stated that, although Peterson's time to perfect his appeal had expired three months before, Peterson had taken no steps to perfect (R. 503).

Consequently, on March 28, 1951, pursuant to Rule XXV of the Court of Customs and Patent Appeals, the Commissioner declared that the interference proceedings were terminated and returned the Peterson application to the Primary Examiner (R. 503-504).

The Primary Examiner again rejected the claims which Peterson copied into his first application from Bodendieck. He held that the Interference Board's decision against Peterson became final when Peterson failed to perfect his appeal in the Court of Customs and Patent Appeals and consequently that that decision was res judicata; and that Bodendieck's disclaimer could in no way affect the determination of priority because one of the Board's reasons had been that Peterson's disclosure did not support the copied claims. However, the Examiner did allow seven of the remaining claims of the first application (R. 246-247).[3]

On April 30, 1954, the Board of Appeals affirmed the Primary Examiner's decision for the reasons relied upon by the Examiner, except that it allowed three additional claims in the first application which had been rejected by the Examiner (R. 298-307, 420). At the petitioner's request, the Board reconsidered its determination but adhered to its affirmance of the Examiner's ruling (R. 308-340, 430). On July 29, 1954, the Assistant Commissioner denied the petitioner's petition for review (R. 342, 348).

[3] As to Peterson's second application, the Examiner finally rejected the copied Bodendieck claims because they were not supported by the disclosure. He did not allow any of the claims in this application (R. 418-419).

From that denial, the petitioner instituted this suit against the Commissioner of Patents to compel him to issue to the petitioner a patent covering the various rejected claims. After lengthy hearings (R. 56–170), the court ruled that the decision by the Interference Board was an adjudication for purposes of res judicata, and consequently the decision by the Board of Appeals, affirming the Examiner's rejection of the interference claims, was not clearly erroneous. In addition, the District Court held that the claims at issue showed no novelty and, consequently, that they were in no event patentable (R. 44–53). Accordingly, the District Court dismissed the complaint (R. 24–25).

The Court of Appeals conditionally vacated the District Court's order (Pet. App. A1–A3). It held that the District Court was not in error in raising the issue of patentability *sua sponte*. But, since that issue was not, as such, tried, the court concluded that the petitioner "may have [been] lulled * * * into a sense of security" (Pet. App. A3). Accordingly, "[i]n the interest of justice", the court vacated the District Court order for sixty days, during which time the petitioner could apply to the District Court for a new trial on the issue of patentability (Pet. App. A3). If the District Court were to deny the application, the petitioner could again appeal to the Court of Appeals, unprejudiced by the conditional vacation. On the other hand, if the District Court were to grant the application, its judgment following the new trial could be appealed by the losing party. The District Court's judgment was

be automatically reinstated at the end of the sixty-day period if the petitioner failed to apply for a new trial during that period.

On August 26, 1958, the petitioner moved in the Court of Appeals for a modification of the court's judgment to permit the sixty-day period to run instead from the date that the court disposed of the petitioner's pending petition for rehearing. That motion was granted on August 26, 1958, and the petition for rehearing denied on September 4, 1958. On November 3, 1958, the District Court granted the petitioner's motion to compute the sixty-day period for applying for a new trial from the date that this Court disposes of the case.

ARGUMENT

1. By its own terms, the judgment of the Court of Appeals was not final. Rather, the District Court's judgment was conditionally vacated in order to permit the petitioner to apply to that court for a new trial. And the time for applying for a new trial has been extended by the District Court until after this Court has disposed of the case. Accordingly, the decree of the Court of Appeals remains interlocutory.

While 28 U. S. C. 1254 (1) permits this Court to review non-final judgments, it is well established that this power will be exercised only where "it is necessary to prevent extraordinary inconvenience and embarrassment in the conduct of the cause" (*Amer. Const. Co.* v. *Jacksonville Railway Co.*, 148 U. S. 372, 384), or an issue is involved which is "fundamental to the further conduct of the case." *Land* v. *Dollar*, 330

U. S. 731, 734; *Larson* v. *Domestic & Foreign Corp.*, 337 U. S. 682, 685. Consequently, the power "is intended to be and is sparingly exercised". *Denver* v. *New York Trust Co.*, 229 U. S. 123, 133. See also *Hamilton Shoe Co.* v. *Wolf Bros.*, 240 U. S. 251, 258; *Boston & Maine R. Co.* v. *United States*, 358 U. S. 68.

The only reason advanced by the petitioner for applying to this Court, before the judgment of the court below becomes final, is that the District Court lacks jurisdiction to pass upon the novelty of the subject matter of the petitioner's patent application. But, even if the petitioner's jurisdictional argument were correct (which we deny), the petitioner will in no way be prejudiced by applying for a new trial since that contention can be asserted again when the judgment of the District Court is again reviewed by the Court of Appeals. And, of course, after final judgment by the Court of Appeals, the petitioner will then again be able to apply to this Court for a writ of certiorari. *Hamilton Shoe Co.* v. *Wolf Bros.*, 240 U. S. 251, 258. Consequently, review by this Court, at this time, is clearly unwarranted.

2. (a) The District Court sustained the rejection by the Patent Office of the petitioner's disallowed claims on the alternative grounds that (1) the unappealed decision of the Board of Patent Interferences rejecting certain of those claims was res judicata, and (2) none of the claims, rejected by the Patent Office, was novel and therefore none was patentable. The petitioner, however, raises objections, at this time, only to the second of the alternative grounds; *i. e.*, he contends

that the District Court lacked jurisdiction to review the patentability of claims which were rejected for reasons other than an absence of novelty. Thus he does not now contest the District Court's holding that the unappealed rejection by the Board of Patent Interferences of the critical claims involved in this litigation (those which were copied from the Bodendieck patent) was *res judicata*. There is, therefore, clearly no necessity for this Court to review this judgment as to those claims.

(b) Moreover, further review by this Court of the limited remaining question is not warranted for the District Court clearly had jurisdiction to review the patentability of the balance of the rejected claims which had been disallowed by the Patent Office for reasons other than res judicata.

The petitioner concedes that, in inter partes cases, the District Court has jurisdiction, and, indeed, an obligation, to review, *sua sponte*, the patentability of the subject matter of the patent application (Pet. 12). It contends, however, that where the proceedings are ex parte, the court lacks that power. This asserted distinction, finds no support either in the patent statutes or the decisions of this, or any other, Court.

In *Hill* v. *Wooster*, 132 U. S. 693, this Court stated that "neither the Circuit Court nor this Court can overlook the question of patentability" even though "the parties appear to have been willing to ignore * * * [that] question * * *". *Id.* at 698. Consequently, despite the fact that the parties limited the issue in that case to priority, it nevertheless was in-

cumbent upon the courts to review the patentability for "[i]t necessarily follows that no adjudication can be made in favor of the applicant, unless the alleged invention for which a patent is sought is a patentable invention". *Ibid.*

The petitioner contends, though, that *Hill* v. *Wooster* is not controlling because that case concerned an inter partes interference proceeding, while the present litigation involves an ex parte suit to compel the issuance of a patent.[4] The supposed rationale for this purported distinction is that the court must act as "stand in" for the Commissioner, as the protector of the public interest, in inter partes proceedings, since in such cases the Commissioner is not a party to the litigation (Pet. 15). The short answer to this, though, is that while the Commissioner is not a party to interference litigation, he must rule that the subject matter of each of the competing claims is patentable before interference can come into being (Patent Office Rule 201, 37 C. F. R. 1.201). And, consequently, there is no less reason in ex parte actions than in interference proceedings for the court to be able to review *sua sponte* the patentability of the subject matter of the application.

Lastly, the petitioner contends that the terms of 35 U. S. C. 145 restrict the jurisdiction of the Dis-

[4] *Hoover* v. *Coe*, 325 U. S. 79, upon which the petitioner strongly relies, does not limit *Hill* v. *Wooster*, *supra*, to inter partes proceedings. Rather, in the *Hoover* case, this Court held only that the District Court has jurisdiction to entertain suits to compel the Commissioner to issue a patent even though the judgment of the court would not "conclude all possible questions as to the right to a patent". *Id.* at 82.

trict Court solely to those elements of the decision by the Patent Office Board of Appeals with which the applicant is "dissatisfied" (Pet. 9). This argument, is obviously untenable since the petitioner concedes that, in interference proceedings pursuant to 35 U. S. C. 146, the court may, *sua sponte*, review the patentability of the subject matter of any of the interfering claims. Yet, Section 146, identically with Section 145, authorizes a civil action by an applicant who is "dissatisfied with the decision * * *" of the Patent Office.

CONCLUSION

For the foregoing reasons, we respectfully submit that the petition for a writ of certiorari should be denied.

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IN THE

SUPREME COURT OF THE UNITED STATES

OCTOBER TERM, 1958

NO. 554

PREFORMED LINE PRODUCTS COMPANY

Petitioner

v.

ROBERT C. WATSON, COMMISSIONER OF PATENTS,

Respondent

ON PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE DISTRICT OF COLUMBIA CIRCUIT

PETITIONER'S REPLY TO RESPONDENT'S OPPOSITION

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Interference Termination

Respondent's statement (Res. Br. 5, 6) regarding termination of the interference between Peterson and Bodendieck points to major differences in viewpoint between respondent and petitioner respecting a critical area of this case.

The real issue before the Court involving the *inter partes* appeal to the Court of Customs and Patent Appeals (CCPA), during the pendency of which Bodendieck purged his patent of the interfering claims by statutory disclaimer, was, and is: What effect did this have on the pendency of the interference?

Petitioner contends that the contest ended December 7, 1950, when the disclaimer was made of record,* while respondent argues that the interference continued in good standing until the limit for perfecting the appeal expired two weeks later, on December 22, 1950.

The very concept that one party to an *inter partes* contest may abandon his claim and withdraw without vitiating the contest is repugnant to the elementary definition of an interference, which is that there must be rival claimants for the invention.**

What remained after the nonsuit effected by the disclaimer was a *de facto ex parte* action involving only the rights of petitioner's assignor, Peterson. The CCPA was without jurisdiction to entertain an appeal, the justiciable issues of which had been extinguished. The Commissioner, relying on CCPA Rule XXV, denied his original jurisdiction to take the necessary action to dissolve the contest as petitioner moved him to do. The trial court later ruled that the Commissioner had original jurisdiction (Conclusion of Law 15, Pet. App. A-13. Order denying defendant's motion to amend by striking this conclusion, Pet. App. A-4). There is thus posed an open conflict between CCPA Rule XXV and Patent Office Rules 262(a) and (d), and Rule 263.

Board of Appeals Denied Review

Respondent's argument *contra* (p. 6) notwithstanding, the Board of Appeals literally held that it was without jurisdiction to review a final rejection, *ex parte*, by the

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* Patent Office Rules 262(a) and (d); Rule 263, Petitioner's Appendix A-18, A-19. Statement of Questions presented to the Court of Appeals, Questions No. 1 and 2, Petitioner's Appendix A-20, A-21, referred to in the 7th Question Presented to this Court, Petition 3. *Lattig et al.* v. *Dean*, 25 App. D.C. 592; 1905 C. D. 698; *Moore et al.* v. *Bradley* v. *Doering, Jr.* 1912 C. D. 205, 180 O. G. 879; *McCoy* v. *Pfeiffer* (CCPA 1943), 133 F. (2d) 913.

** *Lattig et al.* v. *Dean, supra.*

primary examiner, when that rejection was based on, or embodied among its reasons, a decision of the Interference Board and/or of the Commissioner of Patents (Joint App. 341, 431). This would appear clearly to contravene the unequivocal language of the Statute 35 USC §7*, which states ". . . (the) Board of Appeals * * * *shall review* adverse decisions of examiners upon application for patents" (emphasis added) and to contravene Sec. 134 of Title 35* as to petitioner's right to such a review on the merits.

Petitioner is Entitled to a Decision Now

While admitting this petition is properly before the Court, respondent says (p. 9):

> ". . . the petitioner will in no way be prejudiced by applying for a new trial since that contention can be asserted again when the judgment of the District Court is again reviewed by the Court of Appeals. And, of course, after final judgment by the Court of Appeals, the petitioner will then again be able to apply to this Court for a writ of certiorari. . . . Consequently, review by this Court, at this time, is clearly unwarranted."

This reflects a casuistic attitude in total disregard of how petitioner's resources would thus be taxed and dissipated. The first of the applications for patent before the Court came into being in 1946; the second in 1948. For twelve years the issues have been maturing and multiplying. The cost in time, labor, and monetary expense has been great, involving two interferences from inception to judgment; an *inter partes* appeal to the CCPA; two *ex parte* appeals to the Board of Appeals in the Patent Office; innumerable petitions for reconsideration, and to the Commissioner of Patents; and, finally, the proceedings to the District Court

* Petitioner's App. A-14.

under 35 USC §145; an appeal to the Circuit Court of Appeals; a petition for rehearing, and this petition.

Respondent now suggests that petitioner should be sent back to start all over again in the district court, whereby all of its labor for more than four years last past in the federal courts shall be abandoned without a single determinative issue having been decided along the way.

This is repugnant to the ways of our American jurisprudence, and to the principle of expediting the trial of cases in relief of litigants. The Board of Appeals in the Patent Office refused its duty; the trial court went seemingly afield of its duty; the Court of Appeals, likewise, refused to decide any of the affirmative issues in the case; and now respondent would have this Court refuse this petitioner the Writ because it has the power, and because petitioner retains the right to go the circuit court round again if it has the resources to do so. It lies with this Court to afford petitioner relief from such negative thinking that prolongs litigation, frustrates justice, and sterilizes petitioner by legal attrition.

The Whole Case is Before the Court

Petitioner denies respondent's argument (p. 9) that only the jurisdictional issue is raised by its petition. The fifth and seventh questions presented (Pet. 3) clearly embrace those questions of *res judicata* that were before the Court of Appeals (Pet. App. A-20, A-21). Consequently, petitioner does here and now contest the District Court's holding that the Interference Board's decision stands *res judicata* against it, and invites this Court to review the matter under its Supervisory Authority.*

Butterworth v. *Hoe*, 112 U. S. 50, does not warrant re-

* Ridings v. Johnson, 128 U. S. 212, 218; Petition for Rehearing 6

spondent's disregard of the powers invested in the Commissioner of Patents by the Congress. This case, without more, justifies petitioner's sixth question presented to this Court. Nor does respondent take into account why this Court in *Hoover* v. *Coe;* 325 U. S. 79 (an *ex parte* case) reversed the Court of Appeals, which relied upon Hill v. Wooster, 132 U. S. 693, an *inter partes* action.*

The language of 35 USC §145 appears to leave no room for the *sua sponte* ruling of the trial court as to claims not first passed on by the Board of Appeals, which were approved for patent by the Commissioner. In the absence of an assignment of error, *Butterworth* v. *Hoe, supra,* leads to the irresistible conclusion that the Commissioner's judgment favorable to patentability is final, and no reviewable issue remains for referral to the Court under the Statute.

Conclusion

The Writ should issue to settle the jurisdictional question, and to review the several questions appearing in petitioner's Statement of Questions Presented, First to Seventh (Pet. 2, 3), including those before the Court of Appeals (Pet. App. A-20, A-21).

Respectfully submitted,

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